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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/833,502	04/11/2001	Elena shoy		2986

7590  
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EXAMINER

CLARK, AMY LYNN

ART UNIT PAPER NUMBER

1655

DATE MAILED: 11/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/833,502

Applicant(s)

SHOY ET AL.

Examiner

Amy L. Clark

Art Unit

1655

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 1/11/2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 4-6 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 4-6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

### **DETAILED ACTION**

Acknowledgment is made of the receipt and entry of the amendment filed on January 11, 2005 with the cancellation of Claims 1-3, and newly added Claims 4-6.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

**Claims 4-6 are under examination.**

### ***Specification***

The abstract of the disclosure is objected to for the following reasons: The abstract recites, "The present invention concerns that of a new and improved chemical composition for treating and/or removing pimples and acne on a user's face or other body part", in lines 1 and 2. It is suggested that the terms "present invention" and "new" be deleted from the language of the abstract. Once the determination of the novelty of a claimed invention has been established and the disclosure of the invention made public and/or patented, the claimed invention is no longer novel, since the scope of the invention no longer embraces what is considered "novel". Thus, the incorporation of "new" into the language of the abstract is not appropriate. Appropriate correction is required. See MPEP § 608.01(b).

Art Unit: 1655

The amendment filed 01/11/2005 is objected to under 35 U.S.C. 132(a) because it introduces new matter into page 5 of the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: "The volume of rum used would preferably be one cup".

Applicant is required to cancel the new matter in the reply to this Office Action.

### ***Claim Objections***

Claims 5 and 6 are objected to as being dependent upon a rejected base claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Applicant cancelled Claims 1-3 and introduced new claims numbered as 4-6. However, in Claim 5, Applicant claims "A cosmetic chemical composition for treating pimples and acne according to claim 1, wherein the white rum of the volume of white rum would be a generic brand name". In Claim 6, Applicant claims "A cosmetic chemical composition for treating pimples and acne according to claim 1, wherein the white rum of the volume of white rum would be a trademarked brand name".

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 4 is rejected under 35 U.S.C. 112, first paragraph, as failing to provide prior support or antecedent basis for the language "a volume of white rum " and failing to comply with the written description requirement. The claim as set forth in the amendment filed 1/11/2005 contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. In the instant case, the original Claim 1 did not disclose the exact volume of white rum, wherein Applicant claimed, as Claim 1, "a cosmetic chemical composition for treating and/or removing pimples and acne comprising: an amount of white rum and a few teaspoons of rosemary". In the amended Claim 1, Applicant claims, "a cosmetic chemical composition for treating and/or removing pimples and acne comprising: a volume of white rum, the volume preferably being one cup, and a few teaspoons of rosemary", thereby introducing a specific volume, which is considered to be new matter. Insertion of the above mentioned claim limitation has no support in the as-filed specification. The insertion of the limitation is a new concept because it neither has literal support in the as-filed specification by way of generic disclosure, nor are there specific examples of the newly limited genus which would show possession of the concept for a composition comprising 1 cup of white rum and two or three teaspoons of rosemary added to the volume of white rum. There is only one exemplified composition comprising the claim-designated ingredients having the functional effect for treating pimples and acne. This is not sufficient support for the new genus: "a volume of white

rum, the volume preferably one cup". This is a matter of written description, not a question of what one of skill in the art would or would not have known.

The material within the four corners of the as-filed specification must lead to the generic concept. If it does not, the material is new matter. Declarations and new references cannot demonstrate the possession of a concept after the fact. Thus, the insertion of the above mentioned claim-limitation is considered to be the insertion of new matter for the above reasons.

As the above- mentioned claim limitation could not be found in the present specification, the recitation of the claim limitation is deemed new matter; and, therefore it must be omitted from the claim language, unless Applicant can particularly point to the specification for literal support.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Regarding claim 4, the phrase "the volume preferably being" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention.

The metes and bounds of Claim 4 are rendered uncertain by the phrases "a volume of white rum, the volume preferably being one cup" and "two to three teaspoons of rosemary added to the volume of white rum" because the effective amounts of the ingredients are not set forth in terms of either "by weight" or "by volume" amount of the

Art Unit: 1655

total composition. The lack of clarity renders the claims indefinite since the resulting claims do not clearly set forth the metes and bounds of the patent protection desired.

The metes and bounds of Claim 5 are uncertain because it is unclear as to what Applicant means by "wherein the white rum of the volume of white rum" and "a generic brand name".

The metes and bounds of Claim 6 are uncertain because it is unclear as to what Applicant means by "wherein the white rum of the volume of white rum" and "a trademarked brand name".

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Newly submitted Claim 4 is rejected under 35 U.S.C. 102(b) as being anticipated by Greave (A).

Applicant claims a cosmetic chemical composition for treating pimples and acne consisting of: a volume of white rum, the volume preferably being one cup, and two to three teaspoons of rosemary added to the volume of white rum, as Claim 4. Applicant claims a cosmetic chemical composition for treating pimples and acne according to Claim 1, wherein the white rum of the volume of white rum would be a generic brand

Art Unit: 1655

name. Applicant claims a cosmetic chemical composition for treating pimples and acne according to Claim 1, wherein the white rum of the volume of white rum would be a trademarked brand name.

It is noted that the claims now recite "a cosmetic chemical composition for treating pimples and acne consisting of: a volume of white rum, the volume preferably being one cup, and two to three teaspoons of rosemary added to the volume of white rum". It is also noted that the composition disclosed in the cited prior art contains numerous (or additional) ingredients in addition to white rum and rosemary recited in applicant's claims. In the instant case, language reciting "consisting" can be construed as if recited in open "comprising" language, absent some evidence that the additional ingredients in the prior art product materially affect the basic novel properties of the claimed invention:

For the purposes of searching for and applying prior art under 35 U.S.C. 102 and 103, absent a clear indication in the specification or claims of what the basic and novel characteristics actually are, "consisting of" will be construed as equivalent to "comprising."

On the current record there is no evidence that any of the additional ingredients present in the prior art composition would affect the basic and novel properties of the prior art composition such that the prior art composition is truly different than the claimed composition. Thus, applicant's claims must be construed as if reciting "comprising" language, thereby encompassing the additional ingredients in the prior art



Art Unit: 1655

composition, despite the "consisting of" language. A holding of anticipation/obvious is therefore required.

Applicant's main argument is directed to the idea that the amendment to the claims overcome the rejection made in the previous Office action. However, Applicant's argument is not persuasive because Gleave discloses a composition for treating hair and/or scalps of human beings, which contains rum and rosemary. **Further the reference describes how other alcohols could be utilized without departing from the scope of their invention**

The reference anticipates the claimed subject matter.

**No claims are allowed.**

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

Art Unit: 1655

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amy L. Clark whose telephone number is (571) 272-1310. The examiner can normally be reached on 8:30am - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bruce Campell can be reached on (571) 272-0974. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Amy L. Clark  
AU 1655

Amy L. Clark  
October 3, 2005

  
**MICHELE FLOOD**  
**PRIMARY EXAMINER**